

PATENT

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Reply Brief
5-24-01
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Hiroshi Nemoto
Serial No. : 09/196,029
Reissue Application of
U.S. Patent No. 5,577,767,
Issue Date: November 26,
1996
Filing Date : November 19, 1998
For : HOUSING ASSEMBLY FOR AN AIR
BAG AND VEHICLE HORN SWITCH
Group Art Unit : 3618
Examiner : P. Dickson
Attorney Docket No. : TRW(VSSIM)2499RE
Assistant Commissioner for Patents
Washington, D.C. 20231

Brief
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REPLY BRIEF

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Sir:

In response to the Examiner's Answer mailed March 23,
2001, Appellants submit this Reply Brief.

Consideration of the following remarks is respectfully
requested:

1. The inner cover is not critical to all the inventive
aspects of the invention. If the inner cover was critical, it
would seem that an art rejection would be appropriate
regarding the claims that do not recite the inner cover.
However, there is no art rejection of such claims.

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2. Shelton et al., U.S. Patent No. 5,265,904 and Embach, U.S. Patent No. 4,934,735 (both of record) disclose horn switches between inner and outer covers. Yet, these references do not disclose an apparatus as recited in claims 16-18.

3. Reissue claims that are broader in certain respects; but materially narrowed in overlooked aspects (overlooked in the original prosecution), overcome the recapture rule. *Hester Indus. Inc. v. Stein Inc.*, 46 USPQ2d 1641, 1649 (Fed. Cir. 1998). Claims 16-18 have been materially narrowed by the overlooked limitation "said second tear line being spaced apart from said first tear line along a line extending along said first and second tear lines".

4. Appellants maintain that *Hester* is factually distinguished from the case on appeal. The arguments presented in the prosecution in *Hester* clearly and specifically cited features that were critical to patentability. Whereas all that was done in the prosecution of the parent of this reissue application was to list the elements of a claim in sentence form and to state that the art does not disclose an apparatus with those elements.

5. The reissue statute is based on fundamental principles of equity and fairness. *Hester* at 1648. To characterize the arguments presented in the original prosecution as deliberate assertions that a single element must be present in every claim clearly contravenes these principles.

The rejection of claims 16-18 should be reversed.

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Respectfully submitted,


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